

REMARKS

I. CLAIM REJECTIONS UNDER 35 U.S.C. §102(b)

Claims 32-33, 39-40, and 45-49 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,855,576 (LeVeen et al.). Applicants respectfully note that in order to sustain a rejection under §102, each element in the rejected claim must be found, either expressly or inherently, in the cited reference.

Claim 32 recites "a cover removably attached to the probe and adapted for placement on the tissue surface over the target region." (emphasis added) Applicants respectfully submit that LeVeen et al. fails to disclose the claimed element. The Office Action cites element 502 from LeVeen et al. as anticipating the claimed cover. However, element 502 in LeVeen is a "sheath, leaving an access lumen to the target site, as shown in FIG. 11" (Col. 9, lines 41-42). As shown in LeVeen, the sheath does not have a cover for placement on the tissue surface over the targeted region. Thus, the cited element in LeVeen cannot anticipate the claimed element.

Accordingly it is respectfully submitted that claim 32 is not anticipated by LeVeen. Given that claims 33, 39-40 and 45-49 depend from claim 32, Applicants respectfully submit that those claims are not anticipated by LeVeen for at least the same reasons.

II. CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 34 and 50-54 stand rejected under 35 U.S.C. §103(a) as allegedly being obvious in light of U.S. Patent No. 5,855,576 (LeVeen et al.). Applicants respectfully note that in order to sustain a rejection under §103(a), "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings." M.P.E.P. § 2143. Absent a showing of a

teaching or suggestion to combine the teachings or suggestions, a rejection under 35 U.S.C. § 103(a) is inappropriate hindsight-based analysis. See M.P.E.P. § 2145.

As discussed above, LeVeen does not disclose a cover as recited in claim 32. Given that claims 34 and 50-54 depend from claim 32 these claims are patentable over LeVeen.

Furthermore, claims 34 and 50-54 stand rejected under 35 U.S.C. §103(a) as allegedly being obvious in light of U.S. Patent No. 5,855,576 (LeVeen et al.). Claim 34 recites a specific dimension range for a cover. Claim 50 recites specific ranges for a length of a cannula and a diameter of a cannula. Claim 51 recites a specific dimension range for a radius of deployed electrodes. Claims 52-54 recite specific quantities of electrodes. In each of these claims, the ranges or specific numbers are only taught by applicants' own disclosure. Therefore, modifying LeVeen et al. to include these specific dimensions and quantities , as taught only by Applicants' own disclosure, is impermissible hindsight under MPEP § 2145. Accordingly, it is respectfully submitted that claims 34 and 50-54 are patentable over LeVeen based at least on the reason discussed above.

For the foregoing reasons, claims 34, 50-54, which depend from claim 32, are also believed allowable over LeVeen.

CONCLUSION

On the basis of the above remarks, reconsideration and allowance of the claims is believed to be warranted and such action is respectfully requested. If the Examiner has any questions or comments, the Examiner is respectfully urged to contact the undersigned at the number listed below.

Respectfully submitted,

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